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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,418	07/27/2006	Jochen Moench	3775	7301
7590 Striker Striker & Stenby 103 East Neck Road Huntington, NY 11743				
02/12/2008				
EXAMINER				
MACARTHUR, VICTOR L				
ART UNIT		PAPER NUMBER		
3679				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/587,418

Applicant(s)

MOENCH ET AL.

Examiner

VICTOR MACARTHUR

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Preamble-Intended Use

The preamble of claim 1 recites functional intended use limitations that are not taken in combination with the positively recited structure as follows:

In lines 1-3 of the preamble of claim 1, it appears that the applicant does not intend to positively claim “for mechanically connecting a motor housing (2) of a motor (5) to a transmission housing (3) of a transmission (7), in which the motor (5) acts on the transmission (7) via a motor shaft (6)”. For purposes of examination the examiner has considered the claims without combination. “(T)he recitation of a new intended use for an old product does not make a claim to that old product patentable”, *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). Accordingly, the prior art meets the applicant’s claimed intended use merely by being capable of such intended usage regardless of whether or not such capability is expressly disclosed (i.e., wherein capability is inherent to the disclosed structure). If the applicant wishes to positively recite the above intended use phraseology then the limitation “for” should be deleted from line 1 of the claim. Otherwise, it is well established that patentability of a device is based on the structural recitations thereof and not how such structure is intended to be used. The claims are drawn solely to “A connecting device” and it is that “connecting device” structure for which patentability is to be determined. It is noted that applicant’s statement that “only the connection device is intended to be claimed, NOT a combination of the connecting device with the various elements to be connected” (lines 17-18 of page 9 of the Remarks filed 12/17/2007) supports this position.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as follows:

- The term “thin” (line 14 of claim 1) is relative and not well defined and thus renders the scope of the claims unclear. In this regard, it should be noted that, as defined in the specification (see page 8, lines 20-22), “thin” merely requires that the width dimension to be smaller than the height and length dimensions and thus this is how the claim language will be interpreted.
- It is unclear what configuration is being set forth by “configured for mechanically connecting...” (lines 16-17 of claim 1). It appears that this recitation is inclusive of any and all configurations.
- It is unclear if the term “a motor housing” (line 17 of claim 1) is meant to refer to the previously set forth term “a motor housing” (line 2 of claim 1) or to an additional motor housing not previously set forth, thereby presenting an unclear double inclusion of elements. If it is to refer to the previously set forth motor housing, then “a motor” should be changed to --the motor-- at line 17.

- It is unclear if the term “a motor” (line 17 of claim 1) is meant to refer to the previously set forth term “a motor” (line 2 of claim 1) or to an additional motor not previously set forth, thereby presenting an unclear double inclusion of elements.
- It is unclear if the term “a transmission housing” (line 17 of claim 1) is meant to refer to the previously set forth term “a transmission housing” (line 2 of claim 1) or to an additional transmission housing not previously set forth, thereby presenting an unclear double inclusion of elements.
- It is unclear if the term “a transmission” (line 18 of claim 1) is meant to refer to the previously set forth term “a transmission” (line 2 of claim 1) or to an additional transmission not previously set forth, thereby presenting an unclear double inclusion of elements.
- It is unclear if the term “a motor shaft” (line 18 of claim 1) is meant to refer to the previously set forth term “a motor shaft” (line 3 of claim 1) or to an additional motor shaft not previously set forth, thereby presenting an unclear double inclusion of elements.
- It appears that the last line of claim 1 is “(6).”. In view of this, it is not clear whether the claim is incomplete due to an inadvertent omission of intended claim language or whether the comma before the period is merely a typographical error.
- It is unclear if the term “a direction (Z)” (line 3 of claim 2) is meant to refer to the previously set forth term “a radial dimension (Z)” (line 13 of claim 1) or to some additional limitation not previously set forth; thereby presenting an unclear double inclusion of elements.

- The term “the axis” (line 3 of claim 2; and line 3 of claim 3) lacks proper antecedent basis.
- It is unclear whether the term “the motor shaft” (lines 3-4 of claim 2 and line 4 of claim 3) is meant to refer to the recitation in line 18 of claim 1 or the recitation in line 3 of claim 1.
- It is unclear if the term “a direction (X)” (line 3 of claim 3) is meant to refer to the previously set forth term “a radial dimension (Z)” (line 13 of claim 1) or to some additional limitation not previously set forth; thereby presenting an unclear double inclusion of elements.
- It is unclear if the claim 4 recitations of “the motor housing” and the transmission housing” are meant to refer to the elements set forth at the beginning of claim 1 or to the elements set forth at the end of claim 1. Claims 7 and 8 have similar terminology and are thus similarly unclear.
- It is unclear what the metes and bounds of claims 7 and 8 is supposed to be because of the inclusion of the phrase “it is possible to connect...” (line 2 of the respective claims). A claim is to set forth and define actual structure, not “possibilities”. Accordingly, what structure is being required that enables that it be “possible” for the connecting element to be connected to the motor housing or transmission housing?

For the reasons mentioned above a great deal of confusion and uncertainty exists as to the proper interpretation of the claim limitations. In accordance with the MPEP § 2173.06, rejection under 35 U.S.C. 102 or 35 U.S.C. 103 follows based on the examiner’s best understanding of the claim scope.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Zagorski (U.S. Patent 3,401,282).

Claim 1. Zagorski discloses (Figs.1-6) all of the claimed connecting device structure as follows: a connecting device, comprising: at least one connecting element (14) wherein relative to an axial dimension and a radial dimension of the at least one connecting element the at least one connecting element is embodied as thin (relative to thicker objects) in a predetermined circumference direction. Furthermore:

- As detailed above, the prior art structure is substantially identical to the claimed structure such that claimed properties or functions are presumed to be inherent, thus presenting a *prima facie* case (*In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 [CCPA 1977]) and properly shifting the burden of submitting evidence proving otherwise to the applicant (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 [Fed.Cir. 1990]) in accordance with MPEP §2112.01 (I).
- Mere allegation that the prior art is incapable of performing the claimed function, in a declaration or otherwise, is not considered proper evidence much less proof (*In re Schreiber*, 128 F.3d 1473, 1478 44 USPQ2d 1429, 1432 [Fed.Cir.1997]).

- Anticipation of the **claimed structure** automatically results in the assumption of the function to be inherent and further automatically shifts the burden to address functional limitations to the applicant regardless of whether or not the examiner specifically addresses the functional limitations. This is necessary since the Patent Office is unable to obtain, test or compare prior art products. See *Ex parte Martin et al*, decision of the Board of Patent Appeals and Interferences, Patent No. 6,920,019, the paper filed on 11/19/2004, pages 6 and 9. Note that citation of an unpublished decision of the Board of Patent Appeals and Interferences is proper when it is available to the public in the patented file, in accordance with MPEP §707.06. Further note that the examiner is "required or authorized" to adhere to such prior decisions in accordance with the Forward and Introduction section of the MPEP.

Claim 2. Zagorski discloses the connecting device as recited in claim 1. Furthermore:

- The prior art at least one connecting element is fully capable of being substantially rigid (in that it is metal) in a direction (Z) radial to an axis of a motor shaft.

Claim 3. Zagorski discloses the at least one connecting device as recited in claim 1, wherein the connecting element is substantially (when compared to ceramics) elastically deformable (in that the prior art is metal).

- The prior art connecting element is fully capable of performing the intended use of being embodied such that it is orientated with respect to a motor shaft substantially deformable in a direction axial to an axis of a motor shaft.

Claim 4. Zagorski discloses the at least one connecting device as recited in claim 1.

Furthermore:

- The prior art connecting element is fully capable of performing the intended use of being configured to connect a motor housing to a transmission housing, spaced axially apart from it.

Claim 5. Zagorski discloses the connecting device as recited in claim 1, wherein the connecting element is U-shaped.

Claim 6. Zagorski discloses the connecting device as recited in claim 5, wherein the connecting element has a first leg (left leg of 14) and second leg (right leg of 14) that are connected to each other by a bridge piece (top bridge portion of 14).

Claim 7. Zagorski discloses the connecting device as recited in claim 6, wherein it is possible (though not necessary) to connect the connecting element to a motor housing in a region of an end surface of the first leg.

Claim 8. Zagorski discloses the connecting device as recited in claim 6, wherein it is possible (though not necessary) to connect the connecting element to a transmission housing in a region of an end surface of the second leg.

Claim 9. Zagorski discloses the connecting device as recited in claim 6, wherein the connecting element has a recess (recess in 14 receiving 38) and in the region of the recess, the connecting element is substantially concave.

Claim 10. Zagorski discloses the connecting device as recited in claim 9, wherein the recess has an approximately (but not necessarily exactly) ellipsoidal form (in that the recess is a non-circular curve similar to a portion of an ellipse).

Claims 1, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Henderson (U.S. Patent 5,237,871).

Claim 1. Henderson discloses (figs.1-6) **all of the claimed connecting device structure as follows**: a connecting device, comprising: at least one connecting element (visco elastic coated springs of col.2, ll.25-35; and plastic rings of col.7, ll.60-63) wherein relative to an axial dimension and a radial dimension of the at least one connecting element the at least one connecting element is embodied as thin (relative to thicker objects) in a predetermined circumference direction. Furthermore:

- As detailed above, the prior art structure is substantially identical to the claimed structure such that claimed properties or functions are presumed to be inherent, thus presenting a *prima facie* case (*In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 [CCPA 1977]) and properly shifting the burden of submitting evidence proving otherwise to the applicant (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 [Fed.Cir. 1990]) in accordance with MPEP §2112.01 (I).
- Mere allegation that the prior art is incapable of performing the claimed function, in a declaration or otherwise, is not considered proper evidence much less proof (*In re Schreiber*, 128 F.3d 1473, 1478 44 USPQ2d 1429, 1432 [Fed.Cir.1997]).
- See also *Ex parte Martin et al*, decision of the Board of Patent Appeals and Interferences, Patent No. 6920019, the paper filed on 11/19/2004, pages 6 and 9. Note that citation of an unpublished decision of Board of Patent Appeals and Interferences is proper when it is available to the public in the patented file, in accordance with MPEP §707.06.

Claim 11. Henderson discloses the connecting device as recited in claim 1, wherein the connecting element is at least partially comprised of an elastic plastic (plastic rings of col.7, ll.60-63). Note that all plastics inherently have some degree of elasticity.

Claim 12. Henderson discloses the connecting device as recited in claim 1, wherein the connecting element is at least partially coated with a viscoelastic material (visco elastic coated springs of col.2, ll.25-35).

Response to Arguments

Applicant's arguments with regard to the claim rejections have been fully considered but they are not persuasive.

The applicant argues that the prior art does not disclose the limitations involving the motor housing, motor, transmission housing and transmission. This is not persuasive. As detailed above, the applicant is claiming a "connecting device" that is merely intended to be used with these elements, not a connecting device used in combination with these elements, such that patentability must be obtained based upon the device itself rather than elements merely intended to be used therewith. Note also applicant's statement that "only the connection device is intended to be claimed, NOT a combination of the connecting device with the various elements to be connected" (lines 17-18 of page 9 of the Remarks filed 12/17/2007). Prior art need only present structure capable of performing applicant's intended use limitations. The prior art need not specifically describe the intended use or functional limitations, nor specifically describe the capability to perform as such where such capability is inherent to the prior art structure. Inherency of capability to perform intended use and functional limitations is automatically

presumed in prior art that sets forth all of applicant's **claimed** structure until the applicant proves otherwise. See MPEP 2112.01.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

/V. M./

Examiner, Art Unit 3679
February 12, 2008

/Daniel P. Stodola/

Supervisory Patent Examiner, Art Unit 3679